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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/775,423	02/10/2004	Alexander B.H. Bakker	DX0763XB2	9728

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DNAX RESEARCH INC.  
LEGAL DEPARTMENT  
901 CALIFORNIA AVENUE  
PALO ALTO, CA 94304

EXAMINER

O'HARA, EILEEN B

ART UNIT	PAPER NUMBER
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1646

DATE MAILED: 08/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/775,423

Applicant(s)

BAKKER ET AL.

Examiner

Eileen B. O'Hara

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-20 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

## **DETAILED ACTION**

### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-6, drawn to polypeptides, classified in class 530, subclass 350.
- II. Claims 7-9, drawn to binding compounds comprising an antigen binding portion from an antibody which selectively binds polypeptide, classified in class 530, subclass 388.22, for example.
- III. Claims 10-15, 17 and 18, drawn to polynucleotides, vectors, host cells and a method for producing a polypeptide recombinantly, classified in class 536, subclass 23.5, class 435, subclasses 320.1, 252.3 and 69.1, for example.
- IV. Claim 16, drawn to a kit comprising a nucleic acid and a protein, classified in class 530, subclass 350, or class 536, subclass 23.5.
- V. Claim 19, in so far as it is drawn to a method of contacting cell or tissue culture cells with an agonist of unknown composition, class and subclass unclassifiable.
- VI. Claim 19, in so far as it is drawn to a method of contacting cell or tissue culture cells with an antagonist of unknown composition, class and subclass unclassifiable.
- VI. Claim 20, drawn to a method of screening for a compound which blocks interaction of a polypeptide with a receptor, comprising contacting said compound to said polypeptide in the presence of said receptor, classified in class 436, subclass 501, for example.

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2. The inventions are distinct, each from the other because of the following reasons:

Each of inventions I, II and III are unrelated to each of the other inventions. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the polypeptides, binding compounds and polynucleotides are all physically and functionally distinct chemical entities that have different structures, activities and functions.

Inventions I and III are related to the kit of invention IV in that the kit comprises both the nucleic acid and the protein, however the protein of invention I does not require the nucleic acid of the kit and the nucleic acid of invention III does not require the protein of the kit, and would therefore require separate searches, and are thus patentably distinct.

Invention II is related to each of inventions V and VI as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case the binding compounds of invention II could be used as agonist or antagonist of inventions V and VI, but the binding compounds can also be used in a method of purifying protein, which is a materially different method.

Inventions II is unrelated to each of inventions IV and VII. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the binding compounds are not part of the kit of invention IV and are not used in the methods of

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screening for a compound which blocks interaction of proteins to their receptors of invention

VII.

Inventions I and VII are related as product and process of use. In the instant case the protein can be used in a method of screening for a compound which blocks interaction of the protein with its receptor, but the protein can also be used in a method of generating antibodies, which is a materially different method.

Invention I and each of inventions V and VI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the protein is not used in a method of treating cells or tissue culture cells with an agonist or antagonist.

Invention III and each of inventions V, VI and VII are unrelated. In the instant case the nucleic acid is not used in a method of treating cells or tissue culture cells with an agonist or antagonist of the protein or in a method of screening for a compound which blocks interaction of the protein with its receptor.

The methods of inventions V, VI and VII are unrelated to each of the others. The starting materials, methods steps and goals of the inventions are different and are thus patently distinct.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, separate search requirements and/or divergent subject matter, restriction for examination purposes as indicated is proper.

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***Further Restriction Within Groups I-IV and VII***

For whatever group is elected, further restriction within the elected group is required, as follows: human DAP12, rodent DAP12, human DAP10, mouse DAP10, human MDL-1 or mouse MDL-1.

Although classifications for the nucleic acids, proteins, antibodies are overlapping, for instance 536/23.1, each represents a patentably distinct product, having different sequences and structures and requiring separate sequence searches. Therefore, the methods of using the nucleic acids, proteins and antibodies are also patentably distinct.

**Applicants are advised that this is not a species election.**

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

**Rejoinder Under Ochiai/Brouwer**

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable,

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withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04.

**Process claims that depend from or otherwise include all the limitations of the patentable product** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.**

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Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues.

See MPEP § 804.01.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eileen B. O'Hara, whose telephone number is (571) 272-0878. The examiner can normally be reached on Monday through Friday from 10:00 AM to 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Nichol can be reached at (571) 272-0835.


The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (571) 272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

Eileen B. O'Hara, Ph.D.

Patent Examiner

  
EILEEN B. O'HARA  
PRIMARY EXAMINER